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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Richard L. Dunn et al.

Title: COUPLING SYRINGE SYSTEM AND METHODS FOR OBTAINING A MIXED COMPOSITION

Docket No.: 1195.323US1

Serial No.: 10/634,656

Filed: August 5, 2003

Due Date: April 8, 2007

Examiner: Mark K. Han

Group Art Unit: 3767

MS Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

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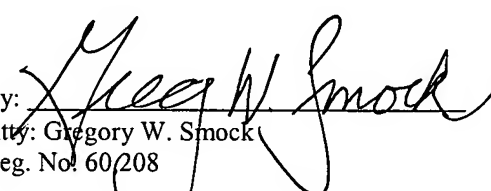
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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

(GENERAL)



SN 10/634,656

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application of:

Richard L. Dunn et al.

Serial No.: 10/634,656

Filed: August 5, 2003

For: COUPLING SYRINGE SYSTEM AND
METHODS FOR OBTAINING A MIXED
COMPOSITION

Examiner: Elizabeth MacNeil

Group Art Unit: 3767

Attorney Docket: 1195.323US1

REPLY BRIEF UNDER 37 CFR § 41.41

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner MacNeil:

This Reply Brief is filed in response to the Examiner's Answer (hereinafter "Answer"), mailed on February 8, 2007, and supplements the substitute Appeal Brief (hereinafter "Appeal Brief") filed by the Appellants on September 1, 2006. This Reply Brief is being filed within the two-month shortened-statutory period for response, as the two-month due date fell on Sunday, April 8, 2007. Accordingly, under the weekend/holiday rule of 37 C.F.R. § 1.7, the Reply Brief is due Monday, April 9, 2006. If necessary, please charge any additional fees or credit overpayments to Deposit Account No. 19-0743.

REPLY

The Appellants have reviewed the Answer, and believe the statements in the Appeal Brief remain accurate and compelling. In responding to the Answer, the Appellants wish to further

clarify certain points of distinction between the pending claims and the cited references in response to the Examiner's newly presented comments.

Reply to Examiner's Answer (10) Response to Argument:

The Examiner's Answer at pages 5-6 states:

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the connection means integrated with either the first syringe or second syringe . . .) are not recited in the rejected claim(s).

Contrary to such position taken by the Examiner, the Appellants reiterate that claim 1 recites, among other things:

[A] first syringe . . . including a first syringe tip with a male end portion . . . a second syringe . . . including a second syringe tip with a female end portion . . . the female end portion having an opening therein, the opening sized and configured to received the tip of the male end portion therein.

(emphasis added.)

In making the above-identified statement at pages 5-6, it appears the Examiner is improperly ignoring the language of claim 1 that defines the structural properties of the first and second syringes (i.e., a first syringe including a first syringe tip with a male end portion; a second syringe including a second syringe tip with a female end portion) and also the language in such claim that defines the direct structural interrelationship between the syringes (i.e., the female end portion having an opening therein, the opening sized and configured to received the tip of the male end portion therein). Appellants respectfully request that the Examiner apply the proper examination procedure as set forth in M.P.E.P. § 2142, which states that the prior art reference (or references) teach or suggest all of the recited claim limitations.

In brief, Appellants assert that the Examiner has improperly refused to consider the complete language of claim 1, including the structural limitation that the first syringe includes a structurally related tip with a male end portion and the second syringe includes a structurally

related tip with a female end portion, and further including the structural interrelationship that the first syringe and second syringe directly couple to one another.

Unlike the Appellants' claimed invention, Chu recites a separate connector means 50 element which is used to connect a first syringe 12 to a second syringe 14. (Chu, col. 3, lines 35-37; col. 4, lines 25-27 and 44-59; col. 6, lines 19-20 and 45-47; FIGS. 1-3.) FIG. 2 of Chu, for example, clearly illustrates that the connection means 50 is an element separate from both the first syringe 12 and the second syringe 14. (*See* FIG. 2 of Chu.) In brief, connector means 50 is not part of the first or second syringe tip (as claimed by Appellants), but rather an element attachable to one or both of the syringe tips. Reconsideration and allowance of Appellants' claim 1 is respectfully requested. Appellants' claims 2-14 are dependent on claim 1 and are patentable over Chu in view of Kanno for the reasons argued above and in the Appeal Brief, in addition to the elements and/or limitations in such claims.

Reply to Examiner's Answer (9) Grounds of Rejection:

The Examiner's Answer at pages 3-4 states or implies:

Chu discloses a coupling syringe system having a first syringe 12 including . . . a first syringe tip [unnumbered] with a male end portion (unnumbered), . . . , a second syringe 14 . . . [including] a second syringe tip 50 with a female end portion (unnumbered) . . . [s]ee Figures 1-3.

In making the foregoing statement, the Examiner appears to implicitly recognize that, unlike the Appellants' claimed invention, Chu requires a separate connection element to be positioned between the syringes to establish a connection therebetween. For example, FIG. 2 of Chu (to which the Examiner refers to, in part, for support of the statement at pages 3-4), clearly illustrates that the connection means 50 is an element separate from both the first syringe 12 and the second syringe 14. In addition, FIG. 2 of Chu illustrates that closed ends 18 and 24 of first syringe 12 and second syringe 14, respectively, include substantially identical male Luer connector tips that are joined by a separate female Luer connector means 50 element. (*See* Chu, col. 4, lines 44-52.)

Furthermore, in making the above-identified statement at pages 3-4, it appears the Examiner is picking and choosing among individual elements of Chu to recreate the Appellants' claimed invention, as prohibited by *Symbol Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 19 U.S.P.Q.2d 1241 (Fed. Cir. 1991). Despite the fact that closed ends 18 and 24 of first 12 and second 14 syringe, respectively, appear identical in FIG. 1-3 (i.e., the cited portions of Chu), the Examiner asserts that first syringe 12 includes an unnumbered male end tip whereas the second syringe 14 includes a female end tip represented by the numeral 50. Appellants submit that if the Examiner asserts that second syringe 14 of Chu includes a tip 50 with a female end portion, the Examiner must also assert that first syringe 12 of Chu includes a tip 50 with a female end portion as the closed ends 18, 24 of such syringes appear and are described as being substantially identical.

In brief, Appellants submit that unlike Chu, the claimed invention does not require a separate connection element to be positioned between the syringes to establish a connection therebetween. Rather, as discussed above, the Appellants' claimed invention recites the first syringe includes a structurally related tip with a male end portion and the second syringe includes a structurally related tip with a female end portion. In addition, the Applicants' claimed invention recites that the structural interrelationship between the syringes is direct (i.e., the female end portion of the second syringe tip has an opening therein, the opening sized and configured to receive the tip of the male end portion of the first syringe therein). Appellants' claims 2-14 are dependent on claim 1 and are patentable over Chu in view of Kanno for the reasons argued above and in the Appeal Brief, in addition to the elements and/or limitations in such claims.

SUMMARY

For the reasons stated above and in the Appeal Brief, Appellants respectfully submit that claims 1-14 were not properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Chu in view of Kanno. Reversal of the rejections and allowance of the pending claims is respectfully requested.

Respectfully submitted,

RICHARD L. DUNN ET AL.

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & LUTH, P.A.

Attorneys for QLT USA, Inc.

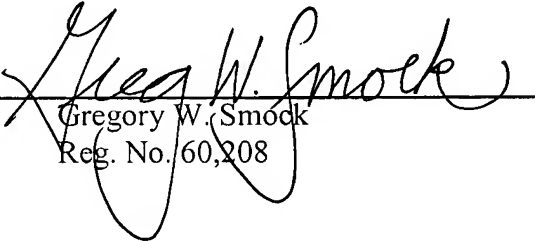
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Date

APRIL 9, 2007

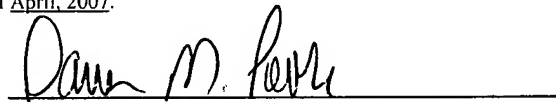
By


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Name



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